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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,583	06/15/2000	John D. Mize	30-5074(4015)	9989

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EXAMINER

GAKH, YELENA G

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/595,583

Applicant(s)

MIZE ET AL.

Examiner

Yelena G. Gakh, Ph.D.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. Amendment, filed on 01/24/02, is acknowledged. Claims 1-58 are pending in the application. No restriction requirements were in fact applied to the application, and therefore all claims were considered.

Response to Amendment

2. Objection of claim 15 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, is withdrawn in view of amendment.
3. Rejection of claims 5, 14-34 and 48 rejected under 35 U.S.C. 112, first paragraph, is withdrawn in view of the Applicant's remarks.
4. Rejection of claims 17-19 and 25-32 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the Applicant's remarks.
5. Rejection of claims 1-58 under 35 U.S.C. 102(e) or 35 U.S.C. 103(a) as being anticipated or unpatentable over the prior art, as set in the first Office action, is withdrawn in view of the Applicant's remarks.

New rejections are set forth in the present Office action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 5, 14-34 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 14 and 48 recite "a type of particulates", or "a type of impurities". It is not clear, what "type" is meant here, since different metal oxides are also impurities of different types, and the method of the instant invention cannot be applied for their determination.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. **Claims 1-16, 20-36, 38-40, 42-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavate in view of Nakanouchi.

Pavate discloses a method of generating information about particulates present in a fluid: "inclusion content of the target may be measured using a wet chemical dissolution technique. In one such method polyethylene beakers are thoroughly cleaned before use. Acids and reagent

water are filtered through 0.45 micron diameter, membrane filters before use. Sample aluminum targets are rough cut by saw to sample sizes such as 1 gram each, then finished to 240 grit on polishing wheels. The samples are then precleaned by dipping in a separate bath of 30% HCl for a short time (e.g., 5 seconds) just before full dissolution, in order to remove any traces from the grinding. The samples are thereafter dissolved to their full extent in a clean aqueous solution having 30% HCl at room temperature or higher. 100 mL is used in the case of 1 gram samples, and 500 mL is used for 10-30 gram samples. **Solids are collected out of the HCl solution on 0.45 micron gridded diameter filters for optical microscopy/SEM analysis, and on 0.22 micron ungridded 47 mm diameter filters for chemical analysis.** Copper is dissolved off using a 10% HNO₃ wash on the filters. All these operations should be carried out in a HEPA filtered laminar flow hood. The washed filters are then allowed to dry in a class 100 clean room, before microscopic examination. The inclusion size distribution may be determined using manual light microscopy techniques such as, ASTM F24 and F25. Oblique lighting should be used to prevent contamination during the analysis" (col.13, lines 14-40). Solids not dissolved in the reagent include metal oxides (Al₂O₃), nitride precipitates, carbide precipitates (col.2, lines 45-50). The silicon content should be less than 1% by weight (col. 11, lines 38, 39).

Pavate fails to disclose automated scanning of a substrate with a microscope with following digital image processing.

Nakanouchi teaches a method of producing fine particles, comprising dissolving a composition in methanol, filtering the solution with depositing undissolved particles on the substrate, drying them and analyzing them with an electron microscope, generating data on their size and shape.

It would have been obvious for anyone of ordinary skill to use automated scanning of the substrate with electron microscope with following digital image processing, as taught by Nakanouchi, in Pavate's method, because the automated scanning is a more advanced technique. Also, see *In re Venner*, 120 USPQ 192 (CCPA 1958) (to provide a mechanical or automatic means to replace manual activity which accomplishes the same result is within the skill of a routineer in the art).

Although Pavate in view of Nakanouchi does not disclose specifically ^a solution containing exclusively aluminum, or copper, or both, or comprising lead or silver, or does not indicate that

the predominant impurity is carbon, it would have been obvious to everyone of ordinary skill that the content of the solution depends on the content of the composition, treated by the "wet chemical dissolution technique", disclosed by Pavate, and can be varied on the bases of routine experimentation.

It would have been obvious that the composition can be obtained from any one of a cast material, a sputtering target, or a solder.

It would have been a routine experimentation for anyone of ordinary skill in the art to spread the impurities of the composition on the substrate in the most convenient way, including subdividing flow pattern into a grid pattern, to optimize the conditions of scanning.

12. **Claims 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavate in view of Nakanouchi, as applied to claims 1-16, 20-36, 38-40, 42-58 above, and further in view of King.

Pavate in view of Nakanouchi does not particularly teach calculating a concentration of undissolved material, e.g. metal oxides or carbon.

King teaches analysis with electron microscope of multielement samples, comprising calculation of the concentrations of different elements in the composition.

It would have been obvious for anyone of ordinary skill to use King's technique of calculating concentrations of undissolved material, including those of different oxides or carbon, in Pavate- Nakanouchi's method of determining the content of the undissolved material by optical microscopy/SEM analysis, because the type and quantity of the undissolved material determines the quality of the composition.

13. **Claims 37 and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavate in view of in view of Nakanouchi, as applied to claims 1-16, 20-36, 38-40, 42-58 above, and further in view Kitamura.

Pavate in view of Nakanouchi does not particularly disclose displaying results as a histogram.

Kitamura teaches a particle analysis method "performed with a **scanning type electron microscope** which directs a narrow, focused electron beam through an electromagnetic lens onto a surface of a sample mounted on a high precision stage in scanning, produces a detection signal representing intensity of secondary electrons or reflected electrons from the sample surface, and

displays a representation of the sample surface based on the detection signal, the method comprising the steps of: reading the image by controlling the **electron microscope** by automatically shifting views produced by scanning the electron beam from a most probable spot where particles may exist to less probable spots in sequence based on information contained in the signal of coordinates of a particle location; determining the particle detection location and acquiring a detection evaluation value in the image, under the assumption that the normal distribution portion of a **histogram** of detection intensity is due to a simple pattern and that the rest of the distribution of the histogram is due to a particle; and scanning a location where particles are determined to exist based on the result of the determining step" (col. 1, lines 35-58).

It would have been obvious for anyone of ordinary skill to represent the results of Pavate-Nakanouchi's method as a histogram, as taught by Kitamura, because it is a convenient way to represent the content of the composition, obtained by optical microscopy/SEM analysis.

Response to Arguments

14. Applicant's arguments filed 01/24/02 have been fully considered. Although the arguments were convincing enough for changing the type of claim rejections in the present Office action, they are not persuasive regarding non-obviousness of the instant application. Pavate in fact does not disclose scanning a substrate (or a portion of substrate, which does not make any difference) with an electron microscope, however, this technique is well known in the art, and its application is in the scope of the skill of any routineer in the art. Moreover, it is not clear, why the Applicants assume, that Pavate "does not disclose or suggest filtering through a substrate", when he explicitly discloses exactly that: "solids are collected out of the HCl solution on 0.45 micron gridded diameter filters for optical microscopy/SEM analysis, and on 0.22 micron ungridded 47 mm diameter filters for chemical analysis". As for the rejection of claims 5, 14-34 and 48 under 35 U.S.C. 112, first paragraph, the examiner misinterpreted the expression "a type of particulates" (or "impurities"), since different metal oxides are also different types of impurities. If the Applicants' meaning of this term is more specific, this should be reflected in the claims. Otherwise, this terminology renders claims indefinite and unclear.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (703) 306-5906. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3899 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

YG
March 15, 2002


Jill Warden
Supervisory Patent Examiner
Technology Center 1700